IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: Plow	)	Art Unit: 3671
Serial No.: 09/922,182	)	Examiner: Mammen
Filed: August 2, 2001	)	**STL9-2000-0035-US1**
For: **SYSTEM, METHOD, AND COMPUTER PROGRAM PRODUCT FOR STORING INTERNET ADVERTISEMENTS AT A USER COMPUTER**	)	February 11, 2005 750 B STREET, Suite 3120 San Diego, CA 92101

APPEAL BRIEF

Commissioner of Patents and Trademarks
Washington, DC 20231

Dear Sir:

This brief is submitted under 35 U.S.C. §134 and is in accordance with 37 C.F.R. Parts 1, 5, 10, 11, and 41, effective September 13, 2004 and published at 69 Fed. Reg. 155 (August 2004). This brief is further to Appellant's Notice of Appeal filed herewith.

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(1) Real Party in Interest

The real party in interest is IBM Corp.

(2) Related Appeals/Interferences

No other appeals or interferences exist which relate to the present application or appeal.

(3) Status of Claims

Claims 1-4, 6-11, and 13-19 are pending and finally rejected, and Claims 5, 12, and 20-22 have been canceled.

(4) Status of Amendments

No amendments are outstanding.

(5) Concise Explanation of Subject Matter in Each Independent Claim, with Page and Figure Nos.

As an initial matter, it is noted that according to the Patent Office, the concise explanations under this section are for Board convenience, and do not supersede what the claims actually state, 69 Fed. Reg. 155 (August 2004), see page 49976. Accordingly, nothing in this Section should be construed as an estoppel that limits the actual claim language.

Claim 1 sets forth a method for storing Internet advertisements at a user computer. The method includes receiving plural Internet advertisements at the user computer automatically without the user requesting them (block 32, figure 2, page 6 first few lines). The method also includes saving plural

advertisements at the user computer (block 40, figure 2, page 6, line 12), allowing a user to access saved advertisements in an advertising history window displaying Internet content composed of plural advertisements (block 44, figure 2, page 6, lines 13-16; figure 3), and allowing a user to filter previously displayed advertisements, so that only advertisements corresponding to one or more user selected attributes are eligible for display, page 7, lines 15-17. The saved advertisements include at least one link to a website and the method further includes recalling a user-selected saved advertisement, with the saved advertisement having at least one link to a website (page 2, first two lines), and accessing the website from the saved advertisement when the link is toggled (id.)

Claim 7 sets forth a system (10, figure 1, page 4) for saving at least one Internet advertisement at a user computer (12, id.). The system includes at least one Web server (22, id.) and at least one database (24, id.) connected to the server, with the database storing plural Internet advertisements. A user computer (id.) is connected to the server via an Internet connection, and the server transmits the Internet advertisements to the user computer while the user is engaged in activity other than requesting the advertisements (page 7, last paragraph). The user computer includes a program for saving at least one Internet advertisement (block 40, figure 2, page 6, lines 11 and 12), with the program displaying plural saved advertisements simultaneously in an advertisement window (figure 3) such that a user may select a saved advertisement from the window for display on the user computer (page 6, lines 15 and 16 and figure 3). The saved advertisements include at least one link to a website (page 2, lines 1 and 2) and the program further includes logic means for enabling a user to select a saved advertisement for display thereof, page 7, lines 15-17, and logic means for accessing the website from the saved advertisement when the link is toggled, id.

The reference numerals above are incorporated into this paragraph by reference. Claim 14 recites a computer program device that has a computer readable means having logic means for storing at least one Internet advertisement. Logic means receive plural Internet advertisements at a user computer. The advertisements are sent to the user computer automatically in response to a user request for information other than the advertisements. Logic means save advertisements at the user computer, and means are provided for allowing a user to select saved advertisements in an advertisement history window displaying Internet content composed only of advertisements (figure 3). Means enable a user to recall at least one user-selected advertisement, and means are provided for accessing the website from the saved advertisement when the advertisement is toggled.

(6) Grounds of Rejection to be Reviewed on Appeal

(a) Claims 1, 3, 4, 6-8, 10, 11, 13, 14, and 16-19 have been rejected under 35 U.S.C. §102 as being anticipated by Kim et al., USPP 2002/0052925.

(b) Claims 2, 9, and 15 have been rejected under 35 U.S.C. §103 as being unpatentable over Kim et al.

(c) Claims 1-4, 6-11, and 13-19 have been rejected under 35 U.S.C. §103 as being unpatentable over Barnett et al., USPN 6,336,099 in view of Landsman et al., USPN 6,317,761.

(7) Argument

As an initial matter, it is noted that according to the Patent Office, a new ground of rejection in an examiner's answer should be "rare", and should be levied only in response to such things as newly presented

arguments by Applicant or to address a claim that the examiner previously failed to address, 69 Fed. Reg. 155 (August 2004), see, e.g., pages 49963 and 49980. Furthermore, a new ground of rejection must be approved by the Technology Center Director or designee and in any case must come accompanied with the initials of the conferees of the appeal conference, id., page 49979.

(a)

Kim et al. bears a filing after the present filing date, and so it is not prior art. Kim et al. claims priority from an earlier-filed provisional application, but the requirements of MPEP §2136.03(III) that the provisional support the later-filed utility application have not been met. By way of non-limiting example, the following portions of Kim et al. relied on in the rejections do not appear in part or at all in the provisional, nor has the examiner attempted to explain where they otherwise might be supported, which is his burden to bear since he is the one offering evidence that on its face is not prior art: paragraphs 75, 77, 78, 106-108 and the referred-to figures therein (11 and 12), and paragraph 110. Until compliance with the MPEP is demonstrated by pointing to where in the provisional, precisely, the relied-upon portions of Kim et al. are supported, those portions cannot be considered to be prior art, and the rejection is overcome.

Although Appellant has analyzed the provisional to promote prosecution, it is not up to Appellant to prove a negative, but rather it is the examiner's burden to prove his own case, which he has failed to do other than offering a vague, general, and in fact inaccurate allegation that the provisional supports everything relied on in Kim et al.

Further, contrary to what is alleged paragraphs 77 and 78 of Kim et al. do not teach an advertising history window displaying Internet content composed of plural advertisements as recited in, e.g., Claim 1.

Rather, what these sections teach is the opposite: "*an* AD is presented ***in the entire display pane***", line 6 of paragraph 77 (emphasis mine); "*an* AD [is overlaid] on the pane so that the ***entire display*** is replaced by the presentation", lines 4-5 of paragraph 78 (emphasis mine).

This careful evaluation of the teachings of Kim et al. have been met with an inaccurate characterization, namely, that "Applicants are arguing limitations that their own claims do not require and that their own specification does not support", despite the fact that Claim 1 in fact recites "allowing a user to access saved advertisements in an advertising history window displaying Internet content composed of plural advertisements" and despite the fact that the examiner immediately confesses, just after the allegation of non-support, that the specification indeed discloses displaying plural ads. The examiner then refers to paragraphs 73, 76, and 106-110 of Kim et al. to show that "Kim et al. does both", but as demonstrated above these paragraphs are not prior art to the claims.

(b) Applicant does not acquiesce that the tags of, e.g., Claim 2 are obvious in light of Kim et al. As admitted in the Office Action, Kim et al. does not teach these tags. That makes them nonobvious, absent evidence of record showing a prior art suggestion to use tags in the context of Kim et al. that would arrive at the present claims, MPEP §2143.01. A general allegation that tags are known, based on personal knowledge of an examiner, is an inadequate substitute for the legal requirement to show where the prior art suggests a modification, in order to support a *prima facie* case of obviousness. Here, Applicant is not claiming "tags" in a vacuum, but rather in the specific combination of other elements that simply can't be dismissed on the basis of an allegation that one of the elements, standing alone, is well known.

(c) With respect to the continued rejections based on Barnett et al. and Landsman et al., the examiner responds to Applicant's previous point that Barnett et al. does not automatically download its coupons by referring Applicant to col. 5, lines 35-46 and alleging that this section teaches "automatically downloading". That is misleading. What the relied-upon section of Barnett et al. teaches is automatically deleting coupons, and automatically updating them, but not automatically downloading them as recited in the present claims. The examiner's latest take on this unfortunate weakness in his case is simply a rhetorical flourish: "Applicants' attempt to draw a distinction between automatically downloading and automatically deleting and updating is without merit...since it would be impossible to automatically update without also automatically downloading". On the contrary, the conjectured "impossibility" does not exist at all, if one actually reads the relied-upon section of Barnett et al., which clarifies that "updating" means "vary the amount of redemption value" of a coupon. This act does not at all require downloading a new version of the coupon but only requires changing a field of an existing coupon that had been previously downloaded ***by the user*** as taught in the reference.

Further, Applicant's strong rationale as to why no fair prior art suggestion to combine the references as proposed remains unrebutted. Modifying Barnett et al. to download the coupons automatically would defeat a purpose of Barnett et al. (to allow a user to decide what coupons to download) and thus would be improper under MPEP §2143.01 (citing In re Gordon), rendering the present claims patentable.

In addition, the allegation that it would have been obvious to modify Barnett et al. to access a Web site by clicking on one of its coupons because Landsman et al. teaches accessing Web sites when advertisements are clicked continues to lack support in the prior art. Regardless of whether advertising information can be contained in the coupons of Barnett et al., they remain coupons intended to be printed out

and redeemed. That is why, as the examiner has been forced to confess, Barnett et al. nowhere teaches accessing web sites by clicking its coupons. Landsman et al. is not directed to coupons or for that matter to advertising contained in coupons.

The proferred motivation to combine - "to provide the users of Barnett with a familiar interface and an ability to access further advertisement information" - fails to bear any relevance to the reference (Barnett et al.) sought to be modified. Specifically, users of Barnett et al. already have a "familiar interface" (a browser), and nowhere does Barnett et al. motivate accessing further information, because it is directed to increasing sales through coupons, not to marketing through advertising. Indeed, Barnett et al.'s casual comment that its coupon file might include advertising (the fact that the advertising consists of "graphics, text, etc." is irrelevant because regardless of its format it is all contained in the coupon file) is simply inadequate to motivate the skilled artisan to toss in the ability to access a web site by clicking on the coupon, ***because the user already is at the intended web site of Barnett et al. by virtue of affirmatively downloading the coupons***. Applicant has quite accurately characterized Barnett et al. and has correctly noted for the above reasons that Barnett et al. and Landsman et al. are apples and oranges, a point that the Board most assuredly will not brush off so lightly.

Respectfully submitted,

John L. Rogitz
Registration No. 33,549
Attorney of Record
750 B Street, Suite 3120
San Diego, CA 92101
Telephone: (619) 338-8075

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APPENDIX A - APPEALED CLAIMS

1. A method for storing Internet advertisements at a user computer, comprising the acts of;

receiving plural Internet advertisements at the user computer automatically without the user requesting them;

saving at least plural advertisements at the user computer;

allowing a user to access saved advertisements in an advertising history window displaying Internet content composed of plural advertisements;

allowing a user to filter previously displayed advertisements, so that only advertisements corresponding to one or more user selected attributes are eligible for display;

wherein the saved advertisements include at least one link to a website and the method further comprises:

recalling a user-selected saved advertisement, the saved advertisement having at least one link to a website; and

accessing the website from the saved advertisement when the link is toggled.

2. The method of Claim 1, wherein the advertisement includes a tag that is a Hypertext Markup Language (HTML) tag.

3. The method of Claim 1, further comprising the act of:

displaying a button; and

in response to the button being toggled, displaying the saved advertisement.

4. The method of Claim 3, wherein plural advertisements are saved and the method further comprises:

allowing the user scroll through the saved advertisements.

6. The method of Claim 1, further comprising the acts of:

displaying a previous button in the advertising window;

displaying a next button in the advertising window; and

accessing saved advertisements when the previous button and next button are toggled.

7. A system for saving at least one Internet advertisement at a user computer comprising:

at least one Web server;

at least one database connected to the server, the database storing plural Internet advertisements; and

at least one user computer connected to the server via an Internet connection, the server transmitting the Internet advertisements to the user computer while the user is engaged in activity other than requesting the advertisements, the user computer including a program for saving at least one Internet advertisement, the program displaying plural saved advertisements simultaneously in an advertisement window such that a user may select a saved advertisement from the window for display on the user computer;

wherein the saved advertisements include at least one link to a website and the program further comprises:

logic means for enabling a user to select a saved advertisement for display thereof, the saved advertisement having at least one link to a website; and

logic means for accessing the website from the saved advertisement when the link is toggled.

8. The system of Claim 7, wherein the program includes:

logic means for receiving plural Internet advertisements; and

logic means for saving at least one advertisement at the user computer.

9. The system of Claim 7, wherein the advertisement a Hypertext Markup Language (HTML) tag.

10. The system of Claim 8, wherein the program further comprises:

logic means for displaying a button; and

logic means for displaying the saved advertisement in response to the button being toggled.

11. The system of Claim 10, wherein plural advertisements are saved and the program further comprises:

logic means for allowing the user scroll through the saved advertisements.

13. The system of Claim 8, wherein the program further comprises:

logic means for displaying a previous button;

logic means for displaying a next button; and

logic means for accessing saved advertisements when the previous button and next button are toggled.

14. A computer program device, comprising:

a computer readable means having logic means for storing at least one Internet advertisement, comprising:

logic means for receiving plural Internet advertisements at a user computer, the advertisements being sent to the user computer automatically in response to a user request for information other than the advertisements;

logic means for saving advertisements at the user computer;

means for allowing a user to select saved advertisements in an advertisement history window displaying Internet content composed only of advertisements;

means for enabling a user to recall at least one user-selected advertisement; and

means for accessing the website from the saved advertisement when the advertisement is toggled.

15. The computer program device of Claim 14, wherein an advertisement includes a Hypertext Markup Language (HTML) tag.

16. The computer program device of Claim 14, wherein the computer readable means further comprises:

logic means for displaying a button; and

logic means for displaying the saved advertisement in response to the button being toggled.

17. The computer program device of Claim 16, wherein plural advertisements are saved and the computer readable means further comprises:

logic means for allowing the user scroll through the saved advertisements.

18. The computer program device of Claim 16, wherein the saved advertisements include at least one link to a website and the computer readable means further comprises:

logic means for receiving plural Internet advertisements, at least one advertisement including a tag; and

logic means for saving at least one advertisement at the user computer at least partially based on the tag.

19. The computer program device of Claim 14, wherein the computer readable means further comprises:

logic means for displaying a previous button;

logic means for displaying a next button; and

logic means for accessing saved advertisements when the previous button and next button are toggled.

APPENDIX B - EVIDENCE

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978.)

APPENDIX C - RELATED PROCEEDINGS

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978.)